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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No 241

SAMUEL O. BLANC,
Petitioner,

vs.

SPARTAN TOOL COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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CASES CITED.

STATUTES.

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PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associated Justices of the Supreme Court of the United States:

Your petitioner, Samuel O. Blanc, prays that a writ of certiorari should issue to review the judgment of the United States Circuit Court of Appeals for the Seventh Circuit entered May 27, 1948 (Rec. p. 556) in the above entitled cause.

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a suit brought by petitioner against respondent for infringement of petitioner's patent Re. No. 22,113, issued July 16, 1942, and based on original patent No. 2,-

111,527, dated March 15, 1938, and petitioner's patent No. 2,069,871, issued February 9, 1937. Reissue patent No. 22,113 relates to a sewer cleaning machine embodying a helically wound flexible coil spring as one of its essential elements which is capable of being wound to a high tension, the same being insertable into a length of drain or sewer pipe for removing roots, debris, and obstructions of various types from the sewer. The machine is also provided with a cutting tool, preferably of the type disclosed in patent No. 2,069,871, which is attached to the free end of the flexible coil spring, the other end of the flexible coil spring being attached to and supported by a storage means in the form of a reel, either of the external or internal type which, when rotated, imparts to the flexible coil spring a rotary motion about its longitudinal axis for rotating and spinning the cutter attached at the free end thereof. The arrangement of the reel and its driving connection to the motion imparting means, as well as the arrangement of the reel to the anti-kinking device and guide for the flexible coil spring at the forward end of the machine, is such that the flexible coil spring may be readily manipulated without damaging the machine and without endangering the operator during the operation of the machine, and particularly when high torque is built up in the flexible coil spring.

The entirely new concept of petitioner's machine resides in the fact that in order to cleanly cut roots and other debris from the inner surface of a sewer or tile, it is necessary to build up a high degree of torque within the mechanical spring which, when released, causes the cutter to rapidly spin. Petitioner's inventive concept contemplates a particular arrangement of the guide and anti-kinking device with respect to the reel so as to provide an effective drive for rotating the flexible spring coil and to provide for the control and manipulation thereof even

when wound to high tension, in which condition it becomes a highly dangerous instrumentality in that the same has a decided tendency to kink and to become uncontrollable.

Cutters made in accordance with patent No. 2,069,871 embody five essential characteristics, described more in detail hereafter, which make them particularly suitable for use as an element of said machine where high torque is built up in the flexible coil spring for cutting roots and the like from sewers.

For the convenience of this Court, Reissue patent No. 22,113 will hereinafter be referred to as the "Machine Patent" and patent No. 2,069,871 as the "Cutter Patent."

The District Court for the Northern District of Illinois, Eastern Division, held claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent invalid for lack of invention over the prior art, and not infringed by respondent, and claims 3 and 6 of the Cutter Patent invalid for lack of invention over the prior art, and not infringed by respondent (Rec. p. 296).

The Court of Appeals for the Seventh Circuit affirmed the judgment of the District Court with respect to invalidity and non-infringement of the specified claims of both the Machine and Cutter Patents (Rec. p. 556).

This petition is directed to a review of the decision of the Court of Appeals with respect to the holding of invalidity and non-infringement of the Machine and Cutter Patents.

Jurisdiction.

1. This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24(7) (28 U. S. C., Sec. 41 (7)).

2. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347).

3. The date of the judgment which petitioner seeks to have reviewed is May 27, 1948 (Rec. p. 556).

Questions Presented.

The decision of the Circuit Court of Appeals for the Seventh Circuit presents the following questions:

1. Whether the conflict between the decision of the Circuit Court of Appeals for the Seventh Circuit in this cause, and the decision of the Circuit Court of Appeals for the Sixth Circuit with respect to the validity of the patents in suit should be resolved in the interest of uniformity of decisions in the various Circuit Courts of Appeals throughout the United States.

2. Whether the conflict between the decision of the Circuit Court of Appeals for the Seventh Circuit in this cause, and the decisions of the Circuit Courts of Appeals for the Sixth and Eighth Circuits and the District Courts within the Eighth Circuit, with respect to the scope and interpretation of the patents in suit, should be resolved in order that the public at large may be properly advised as to what devices and mechanisms constitute infringements of the patents in issue.

3. Whether the Circuit Court of Appeals for the Seventh Circuit properly held that the claims of the Machine and Cutter Patents in issue are invalid as lacking invention, and that respondent's machine and cutters do not infringe said claims.

4. Whether in an ordinary patent suit, as in the instant case, where the suit was instituted and prosecuted in good faith, and the record is absolutely devoid of any showing of fraud or dilatory practices on the part of petitioner or that respondent has been subjected to harassment or unfair, oppressive or vexatious litigation, a District Court is justified in assessing attorneys' fees against

petitioner under the general provisions of Revised Statutes, 35 U. S. C. A. Sec. 70.

5. Where it is unlikely and highly improbable that Circuit Courts of Appeals will review and interpret the general provisions of Revised Statutes, 35 U. S. C. A., Sec. 70 (with the possibility of ultimate conflict of decisions), with respect to when the assessment of attorneys' fees is proper, because of the discretionary powers reposing in the District Courts (the decision of the Circuit Court of Appeals for the Seventh Circuit in this case probably being typical of such Courts' unwillingness to ascertain the determinative facts with respect to whether the assessment of attorneys' fees in any case is justified), whether the conflict between the decision of the District Court for the Northern District of Illinois, Eastern Division, in this cause, and the decisions of the District Courts of the Third and Sixth Circuits, with respect to the interpretation and application of Revised Statutes, 35 U. S. C. A., Section 70, as it applies to the assessment of attorneys' fees in any particular case, should now be resolved and said Statute construed by this Court in the interest of the public and the uniform application and administration of federal justice.

Reasons for Granting the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

(1) The Court of Appeals for the Seventh Circuit has held claims 4, 5, 7, 8, 9, 10 and 11 of petitioner's Machine Patent invalid, whereas the Court of Appeals for the Sixth Circuit, in the earlier cases of *Blanc* v. *Curtis,* 119 F. 2d 395, and *Blanc* v. *Cayo,* 139 F. 2d 695, held claim 4 of petitioner's Machine Patent valid. In the former case, claim 4 was the only claim involved, while in the latter case, the Court of Appeals expressly overruled the trial

court's decision in holding claim 4 invalid as being in contravention to the decision in *Blanc* v. *Curtis,* 119 F. 2d 395, and decided the case with respect to claims 5, 7, 8, 9, 10 and 11 also in issue, solely upon the ground of non-infringement. Under similar circumstances, certiorari was granted by this Court in *Ensten* v. *Simon, Ascher & Company, Inc.,* 282 U. S. 445, *Smith, Administratrix* v. *Springdale Amusement Park, Limited, et al.,* 283 U. S. 121, *Permutit Co.* v. *Graver Corporation,* 284 U. S. 52, and *Electric Cable Joint Co.* v. *Brooklyn Edison Co., Inc.,* 292 U. S. 69.

(2) The Court of Appeals for the Seventh Circuit held claims 4, 5, 7, 8, 9, 10 and 11 of petitioner's Machine Patent in suit, not infringed by respondent's machine, whereas the Court of Appeals for the Sixth Circuit in the earlier case of *Blanc* v. *Curtis,* 119 F. 2d 395, in considering claim 4 of the original of the Reissue Machine Patent, evaluated petitioner's contribution in the art, and in construing said claim 4 then in issue, ascribed to petitioner's invention the very device complained of in this cause. The District Court for the Southern District of Iowa, Southern Division, in the case of *Blanc* v. *Longstaff* and *Blanc* v. *Smith,* 58 U. S. P. Q. 54, recognized the precedent established by the decision in *Blanc* v. *Curtis,* 119 F. 2d 395, and held petitioner's Machine and Cutter Patents valid and infringed by the defendants, Longstaff and Smith, the defendant Longstaff's machine being in all essentials identical with respondent's machine in this case.

(3) The Court of Appeals for the Seventh Circuit has held claims 3 and 6 of petitioner's Cutter Patent in suit invalid as lacking invention over the prior art, whereas the Court of Appeals for the Sixth Circuit in the earlier case of *Blanc* v. *Curtis,* 119 F. 2d 395, held claims 3 and 6 of this patent valid and construed the patent as disclosing a meritorious invention which substantially ad-

vanced the art. It further held that the patent was entitled to a liberal construction. In deciding the case of *Blanc* v. *Curtis,* 119 F. 2d 395, the Court of Appeals for the Sixth Circuit emphasized that its decision with respect to the patents was in conformity with the decisions reached by the District Court for the Southern District of Iowa, Southern Division, in the cases of *Blanc* v. *Weston,* 33 U. S. P. Q. 466, *Blanc* v. *Weston,* 35 U. S. P. Q. 150, and *Blanc* v. *Weston,* 42 U. S. P. Q. 427. The decision of the Court of Appeals for the Eighth Circuit in the case of *Blanc* v. *Weston,* 109 F. 2d 911, with respect to the scope and interpretation of the claims of petitioner's Cutter Patent is not inconsistent with the decision in *Blanc* v. *Curtis,* 119 F. 2d 395, but is in conflict with the decision of the Court of Appeals for the Seventh Circuit in this cause.

In its holding, the Court of Appeals in the case of *Blanc* v. *Curtis,* 119 F. 2d 395, held the cutters manufactured and sold by the defendant Curtis, which are in their essentials indistinguishable from respondent's cutters in the present case, to constitute infringements of claims 3 and 6 of petitioner's Cutter Patent.

(4) That an important question of federal law which has not been settled, but should be settled by this Court, is presented by the decision of the District Court and the Court of Appeals for the Seventh Circuit in this case, in allowing respondent attorney's fees, where the record fails to show that the case is other than an ordinary patent case and that there are any special circumstances of gross injustice prejudicial to respondent's interests and position. The assessment of attorney's fees under Revised Statutes, 35 U. S. C. A., Section 70, being a discretionary matter not reviewable by Circuit Courts of Appeals in the absence of abuse, it becomes necessary for this Court at the present time to define and interpret this Section

of the Statutes to resolve the conflict existing between the decision of the District Court in this case and the decisions in *Juniper Mills, Inc.*, v. *J. W. Landenberger & Co.*, 76 U. S. P. Q. 300 (D. C., E. D., Penn.), *National Brass Co.* v. *Michigan Hardware Co.*, 75 F. Supp. 140 (D. C., W. D., Mich., S. D.), and *Lincoln Electric Co.* v. *Linde Air Products Co.*, 74 F. Supp. 293 (D. C., N. D. Ohio E. D.), in the interest of uniformity and consistency in the decisions with respect to this question and in order that an authoritative precedent may be established for all Circuits throughout the United States.

Wherefore, it is respectfully submitted that a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit should be granted.

GORDON F. HOOK,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The findings and conclusions of the United States District Court for the Northern District of Illinois, Eastern Division, were filed June 19, 1947 (Rec. p. 283) and the judgment entered pursuant thereto on June 26, 1947 (Rec. p. 306).

The opinion of the Circuit Court of Appeals for the Seventh Circuit was filed May 27, 1948 (Rec. p. 548). It is reported in 168 F. 2d 296.

Jurisdiction.

Note petition (*supra*, p. 3).

Statement of the Case.

The essential facts of the case are stated in the accompanying petition for writ of *certiorari*.

Specification of Errors.

The errors which petitioner will urge if a writ of *certiorari* is issued are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding that claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent are invalid, and not infringed by respondent's sewer cleaning machine.

2. In holding that claims 3 and 6 of the Cutter Patent are invalid, and not infringed by respondent's cutters.

3. In approving the District Court's finding that attorneys' fees should be assessed against petitioner in this case.

ARGUMENT.

Validity of Machine and Cutter Patents Sustained.

The validity of the original and Reissue Machine Patent, as well as the Cutter Patent, has been sustained by the Court of Appeals for the Sixth Circuit in its prior decisions in *Blanc* v. *Curtis,* 119 F. 2d 395 and *Blanc* v. *Cayo,* 139 F. 2d 695, the Court of Appeals for the Eighth Circuit in *Blanc* v. *Weston,* 109 F. 2d 911, and the District Court for the Southern District of Iowa, Southern Division, in 58 U.S.P.Q. 54, 42 U.S.P.Q. 427, 35 U.S.P.Q. 150 and 33 U.S.P.Q. 466. Prior to the present decision, both patents have been sustained with the exception of the case of *Blanc* v. *Cayo,* 50 F. Supp. 552, in which the District Court for the Western District of Michigan, Southern Division, held claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent, and claims 1 to 6 of the Cutter Patent invalid in view of the prior art, and not infringed by the defendant Cayo. In that case on appeal (139 F. 2d 695), the Court of Appeals for the Sixth Circuit expressly reversed the trial court with respect to its holding of invalidity of claim 4 and decided the case with respect to all of the claims of both patents in issue on the predicate of non-infringement.

Such findings, on the authority of *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.,* 321 U. S. 275, 278, *Williams Co.,* v. *United Shoe Machinery Corp.,* 316 U. S. 364, 367, and others, should not be disturbed by this Court and the issues herein should be limited to the determination of infringement of the patents involved.

Machine Patent.

The petitioner, Blanc, through the inventions of the patents in suit, was the first to disclose to the art the

combination of a machine and cutter (Machine Patent, claim 11) in which high torque could be built up within the flexible spring element, which could be safely manipulated and controlled and which, as one of its essential characteristics, operates on the principle of releasing such torque for rapidly rotating the cutter for effectively cleaning the interior surface of sewers, drains and the like. The machine and cutters of the two patents involved are of novel construction and possess recognized practical and commercial merit.

The sewer cleaning machine of the Machine Patent in suit differs from all other machines of the prior art in that the same embodies a combination of elements which cooperate and co-act in a manner entirely foreign and distinct to anything suggested in the prior art for the cleaning of such sewers and drains. Whereas, for the most part, the prior art machines were confined to structure capable of operating merely to ram or dislodge the stoppage in sewers and the like, petitioner's Machine Patent has the novel characteristic of being able, not only to accomplish such functions, but also to operate in the manner described to assure cleaning of the sewer at the inside surface thereof. Petitioner's patented machine and its principle of operation are not disclosed or even suggested in the prior art.

The Circuit Court of Appeals for the Sixth Circuit, in the case of *Blanc* v. *Curtis*, 119 F. 2d. 395, recognized petitioner's contribution in the art and, while it was of the opinion that the various elements of the combination were not new, nevertheless, it ascribed invention to petitioner's sewer cleaning machine.

After pointing out that the flexible shaft of petitioner's machine was the same as the flexible element of the Stremel patent No. 1,616,833 (119 F. 2d. 396) it discussed, among others, the three principal patents to Yohn, Nos.

2,037,103 and 2,037,104 and Kugelman No. 2,042,407, and concluded that invention was involved with the following remarks:

> "The amount of power stored in Blanc's spring coil is very high and the working out of a device which would control this amount of power and at the same time fulfill the other needs of the work to be done in the ordinary house sewer required more than mechanical skill. We conclude that claim 4 is valid."

The decision of the Circuit Court of Appeals for the Sixth Circuit affirmed the opinion of the Patent Office that invention was involved in allowing the claims in the original and reissue applications over these prior art patents.

The Circuit Court of Appeals for the Sixth Circuit in its decision in *Blanc* v. *Cayo,* 139 F. 2d 695, specifically reaffirmed its holding of validity of claim 4 and, accordingly, it must have agreed that petitioner's Machine Patent discloses inventive ingenuity, as expressed in its prior decision in *Blanc* v. *Curtis.*

The Circuit Court of Appeals for the Seventh Circuit in the present case, premised its holding of invalidity of the claims of the Machine Patent on the theory that the elements of petitioner's machine were old and that the same function no differently than corresponding elements in the prior art. It made reference to the disclosure of flexible shafts (Rec. p. 552) in patents of the prior art, comparable in all respects to the Stremel patent No. 1,616,833 referred to for the same purpose by the Circuit Court of Appeals for the Sixth Circuit in deciding the case of *Blanc* v. *Curtis.* The Court of Appeals then proceeded to give its interpretation of three prior art patents which it considered to fully anticipate petitioner's contribution in the art, and on which it rested its conclusion that no invention was involved. These are the Yohn

patents Nos. 2,037,103, 2,037,104 and the Kugelman patent No. 2,042,407. These patents were reviewed by the Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis*, but that court held that the same were not anticipatory and concluded that petitioner's contribution amounted to inventive ingenuity. The Court of Appeals in this case concluded its opinion with respect to the invalidity of petitioner's Machine Patent with the following remarks:

> "To us it appears that all the elements of 113 were old in the art and functioned no differently in plaintiff's patent than they did in the prior art. Bringing together of old devices, without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention, *Adams* v. *Bellaire Stamping Co.*, 141 U.S. 539, and when no new function results from a combination of elements and the new result is merely that which arises from the operation of each one of the elements, the arrangement does not constitute invention. 'There is merely an "aggregate of old results."' *General Machinery Corp.* v. *Clearing Machine Corp.*, 99 F. 2d 20, 27. See also *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549; *McIlvaine Patent Corp.* v. *Walgreen Co.*, 138 F. 2d 177; and *Allen-Bradley Co.* v. *Square D. Co.*, ... F. 2d ....., decided by this court on March 6, 1948."

Thus, it will be seen that the decisions of the Court of Appeals for the Sixth Circuit and the decision of the Court of Appeals for the Seventh Circuit in this cause, are irreconcilable and in complete conflict with one another, not only from the standpoint of the conclusions reached, but the premises and reasoning advanced in support of such conclusions.

The specific embodiment of petitioner's invention is shown in the patent (Rec. p. 336). From the drawings and description, it clearly appears that the machine comprises an elongated flexible element 49 of coiled spring

wire which is capable of being inserted to any length in a sewer pipe, and when the end thereof is held against rotation by the cutter 56 engaging roots and the like, of being wound to high tension; a reel 28 for holding and storing the flexible spring element; guide means 20, 21 on the axis of rotation of the reel through which the flexible spring element passes when it is fed onto and off of the reel; a motor 57 for imparting rotational movement to the reel and to the flexible spring element; and an anti-kinking device in the form of a tubular member 35 which imparts a crank-like formation to that portion of the flexible spring element lying between the reel and the guide, and which maintains its crank-like formation against kinking under conditions of high tension so that at all times during the operation of the device, the flexible spring element may be turned by the crank and thereby be wound up to create the high tension required for the cutting of roots and the like. This tension when released functions to exert a high and quickly applied force to the root cutter 56 which is mounted on the inner end of the flexible spring element, with the result that roots and the like are quickly and effectively removed from the sewer.

The action of the flexible coil spring is more particularly described in the patent (Rec. p. 338, (p. 2 of Patent), lines 49 to 59, col. 2).

It will be noted that the specific illustrative form of the invention of petitioner's Machine Patent embodies a reel of the external type, that is to say, one in which the flexible spring element is stored upon the outside of the reel in contradistinction to a reel of the internal type in which the flexible spring element is stored within the confines of the reel. The question as to whether these two forms of reels are mechanical equivalents in the combination of the Machine Patent, was first raised for judicial determination before the Court of Appeals for the

Sixth Circuit in the case of *Blanc* v. *Curtis,* 119 F. 2d 395. That court held that such reels are equivalents in the combination, and stated (p. 397):

> "In appellees' machine (Patent 1,963,561, issued to Sanger), the shaft is coiled inside an annular space within the periphery of the drum or reel rather than wound on a hub in the usual manner. Appellant's commercial embodiment of the patent also uses an internal reel rather than the external reel shown in the drawings and we regard the difference between the reels as immaterial."

Claim 4 of petitioner's Machine Patent was the only claim then in issue and in view of the above, that court necessarily decided that claim 4 is not limited to a machine in which an external type of reel is employed, and ascribed to petitioner's invention, as defined by said claim, a device embodying an internal type of reel.

It is further apparent from that decision (p. 397) that while the court was unwilling to interpret the claim as being infringed by the device then in issue (exemplified in the Sanger patent No. 2,167,268, (Rec. p. 496)), because of what it considered to be a material difference in the anti-kinking devices employed, nevertheless, it is apparent from the decision that the court did not intend that claim 4 should be limited to exclude those devices in which a tubular anti-kinking device forms a part of the assembly.

In arriving at the decision in the case of *Blanc* v. *Curtis,* the Court of Appeals had occasion to refer to the decision of the District Court for the Southern District of Iowa, Southern Division, in the case of *Blanc* v. *Weston,* 42 U.S.P.Q. 427, in which claim 4 of the Machine Patent was similarly construed.

In the later cases of *Blanc* v. *Longstaff* and *Blanc* v. *Smith,* 58 U.S.P.Q. 54, the same District Court in recog-

nizing the precedent established by the Court of Appeals for the Sixth Circuit in *Blanc* v. *Curtis*, with respect to claim 4, held the defendants' devices to infringe claims 4, 5, 7, 8, 9, 10 and 11 of the Machine Patent.

The structure of respondent's sewer cleaning machine can be best determined from the physical machine itself, Defendant's Exhibit A, and the cut (Rec. p. 247) appearing as Defendant's Exhibit W-1 and, as constructed, contains all of the novel characteristics of the invention of the Machine Patent, and fully responds in every respect to the definition which the Circuit Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis*, gave to the Blanc invention.

Respondent's machine employs a flexible spring element in which the unused portion is held by a reel of the internal type and is rotated by a motor which drives the reel. The flexible spring element passes through a tubular member having a guide portion on the axis of rotation of the reel for controlling the flexible spring element while the same is payed out from and retracted into the reel. The tubular member which integrally embodies the guide at the front of the machine is adapted to rotate with, or relative to, the reel, and serves as a means for preventing kinking of the flexible spring element when high torque is wound into the same and manipulated to cut roots and the like in sewers. The tubular member also disposes the flexible spring element in crank-like formation with respect to the reel and its axis of rotation, whereby the same may be rotated about its longitudinal axis for rotating the cutter and for winding torque into the flexible spring element.

The operation of respondent's machine is described in respondent's bulletin (Rec. pp. 203-206).

Of the seven claims in issue, claims 4 and 11 may be

taken as typical, it being noted that claim 10 sets forth the identical structure of claim 11 except for the incorporation of the cutter which constitutes an element of the combination of claim 11. It will be observed that respondent's device responds literally and in spirit to the terms of said claims. The device incorporates an internal type of reel which the Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis* held to be equivalent to the external type of reel of the specific embodiment of the invention disclosed in petitioner's patent. Respondent's machine also includes a tubular anti-kinking device which, in combination with the other elements as arranged in respondent's machine was ascribed by that court as constituting petitioner's invention, as defined in claim 4 of the Machine Patent.

It is to be observed that the Circuit Court of Appeals for the Seventh Circuit in this case decided the issue of validity adversely to petitioner and merely affirmed the judgment of the District Court with respect to infringement without comment. Finding of Fact 16 (Rec. p. 291) is to the effect that in a sewer cleaning machine as disclosed by petitioner's Machine Patent, reels of the internal and external type are not equivalents. Finding of Fact 15 (Rec. p. 290) is to the effect that the tubular member of respondent's device is not the equivalent of, and does not function to perform the same results as, the anti-kinking tubular element of the patented structure.

Such findings of fact are incompatible with the findings of the Circuit Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis*, and the Circuit Court of Appeals for the Seventh Circuit, in affirming the District Court in this case, has brought about a conflict with respect to infringement of petitioner's Machine Patent which requires clarification by this Court.

Cutter Patent.

The invention of this patent relates to a specially designed and constructed cutter which is capable of functioning as the cutter element attached to the end of the flexible spring element of a sewer cleaning machine made in accordance with the invention of the Machine Patent.

The cutter of the patent (Rec. p. 332) comprises a head adapted to be attached to the flexible spring element at one end, and has blades attached to the other end for cutting roots and removing debris from sewers and the like. The assembly is characterized as embodying the following essential features, namely—

(a) The blades must diverge outwardly from the mounting hub;

(b) The blades must be capable of flexing inwardly and outwardly in such manner that they may be pressed together so as to enter and pass through small restrictions in pipes, such as encountered at inlet openings and at joints and bends therein, and when once inside to again expand to their original positions;

(c) The blades must have rearwardly inclined cutting edges and be capable of exerting a holding action with respect to an obstruction for stopping the end of the flexible spring element to cause the same to wind up to create the required high tension therein, and at the same time exert a draw cutting action to sever roots and the like when the spring tension is released and high rotary motion is imparted to the cutter;

(d) The leading ends of the cutter must be turned inwardly to produce a sled-runner action in sliding over and passing restrictions and bends in the pipe; and

(e) The blades must have such flexibility as to be capable of responding to centrifugal force produced by the high speed rotary motion created when the high-ten-

sion spring is released, so as to be expanded by such force to a maximum divergence and to thereby engage the inner surface of the pipe or sewer, irrespective of the size thereof, and to cut the roots or other debris flush with the pipe surface, with the result that the pipe is entirely freed of all obstructions.

The action of the cutter is described in the specification of the patent (Rec. p. 334 (p. 2 of Patent), lines 6 to 19, Col. 1).

Petitioner's Cutter Patent was held valid by the Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis,* 119 F. 2d 395, and was recognized as covering a pioneer implement and entitled to be liberally construed. It was therein stated (p. 339):

> "Appellant's cutter is a pioneer implement, and should be given a construction sufficiently broad to realize the purpose of the patent. It is a meritorious improvement, substantially advancing the art, and is entitled to a liberal construction. *National Battery Co.* v. *Richardson Co.,* 6 Cir., 63 F. 2d 289, 293. Appellant's and appellees' cutters are substantially identical, operating on the same principle and accomplishing the same result in substantially the same way. *Cf. Sanitary Refrigerator Co.* v. *Winters,* 280 U.S. 30, 50 S. Ct. 9, 74 L. Ed. 147; *Sun Ray Gas Corp.* v. *Bellows-Claude Neon Co.,* 6 Cir., 49 F. 2d 886. The use of a knife practically identical with one of the accused cutters was held in *Blanc* v. *Weston,* 35 U.S.P.Q. 150, to violate the injunction issued in *Blanc* v. *Weston,* 33 U.S.P.Q. 466."

The scope and interpretation given to claims 3 and 6 by the Court of Appeals in holding the same valid and infringed by appellees' cutters in the case of *Blanc* v. *Curtis,* conforms in all respects to that of the District Court for the Southern District of Iowa, Southern Division, in the cases of *Blanc* v. *Weston,* 33 U.S.P.Q. 466,

and *Blanc* v. *Weston,* 35 U.S.P.Q. 150, referred to and acquiesced in by the Court of Appeals in deciding that case.

As with respect to the Machine Patent, the case of *Blanc* v. *Curtis* established a precedent which was followed in the cases of *Blanc* v. *Smith* and *Blanc* v. *Longstaff,* 58 U.S.P.Q. 54, wherein the District Court for the Southern District of Iowa, Southern Division reiterated its position with respect to the Cutter Patent in holding claims 1 to 6, inclusive, valid and infringed by the defendants therein.

In contrast to the interpretation given claims 3 and 6 of the Cutter Patent by the Court of Appeals for the Sixth Circuit in *Blanc* v. *Curtis,* the Circuit Court of Appeals for the Seventh Circuit in this case, held the identical claims invalid on the ground that no invention was involved in combining those elements which it considered to be old in the art on the theory that no new function was performed by the device.

Respondent's cutters (Def. Exs. B-1 to B-4) are fairly represented and their operation described in respondent's bulletin (Plf. Ex. I, Rec. p. 203) and, as will be apparent, possess all of the peculiar characteristics and special features above enumerated which identify petitioner's contribution in the art. Such cutters are designed to be introduced through a small opening of a pipe, and then expand to the diameter of the larger tile under the action of centrifugal force, and finally engage roots and other debris, exert the holding action requisite for winding high tension in the flexible spring element (where such action is necessary) and chop or cut roots or other debris flush with the tile wall when the high tension is released.

While respondent's cutters are formed with blades in opposed relation to one another, this, however, was consid-

ered immaterial by the Court of Appeals for the Sixth Circuit in the case of *Blanc* v. *Curtis*, 119 F. 2d 395, in conformity with the broad interpretation placed upon claims 3 and 6 then in issue.

The court therein stated (p. 399):

> "In view of the construction that we give this patent we do not consider these variations material, nor that the rearward inclination of the blades as distinguished from that of the cutting edges is the gist of appellant's invention. We agree with the Court of Appeals for the Eighth Circuit (*Blanc* v. *Weston*, 109 F. 2d 911, 912) that an essential characteristic of the Blanc cutter patent is a thin flexible cutting member of very high resilience. * * *"

Similar cutters were held to be infringements of claims 3 and 6 in the case of *Blanc* v. *Curtis*. The cutters held to infringe in that case are reproduced in this record, pages 212 to 216, inclusive.

While the Circuit Court of Appeals for the Seventh Circuit decided the issues with respect to the Cutter Patent solely on the ground of invalidity thereof, it affirmed the judgment of the District Court in its finding that respondent did not infringe on the basis that respondent's cutters did not embody the essential elements above recited which characterize petitioner's contribution in the art.

The situation as it involves petitioner's Cutter Patent is similar in all respects to the Machine Patent, namely, irreconcilable conflict with respect to both validity and infringement between the decision of the Circuit Court of Appeals for the Sixth Circuit as expressed in the case of *Blanc* v. *Curtis* and the decision of the Circuit Court of Appeals for the Seventh Circuit in this case. Similar conflict with respect to the Cutter Patent exists between the decision in this case and the decisions of the District

Court for the Southern District of Iowa, Southern Division, in the cases above cited, which are clearly in conformity with the decision in the case of *Blanc* v. *Curtis*. The situation is such that it is necessary for this Court to review the Cutter Patent, and that the questions with respect to validity and infringement be resolved in order that there may be a determinative evaluation of this patent in the interest of uniformity of decisions of the Circuit Court of Appeals throughout the United States.

Attorneys' Fees.

The Revised Statutes, 35 U.S.C.A., Sec. 70, as amended, provides that

> "A court may in its discretion award reasonable attorneys' fees to the prevailing party upon entry of judgment in any patent case."

At the time of entry of judgment by the District Court in this case, no Federal Court had rendered a decision interpreting this amended Statute and indicating under what circumstances attorneys' fees should be assessed against the losing party in a patent suit. The intent of the Statute is explicit, as set forth in the Senate Report No. 1503, June 14, 1946, U.S. Code Congressional Service, 79th Congress, Second Session, 1946, that recovery of attorneys' fees will not become an ordinary thing in patent suits. The District Court indicated very clearly (Rec. pp. 303, 305) at the time of entry of the judgment, that this question as to whether or not this was a proper case in which to assess attorneys' fees should be raised in the Court of Appeals. The record shows that such question was in effect certified to the Court of Appeals for determination.

The Circuit Court of Appeals for the Seventh Circuit (Rec. p. 555) however, refused to review the point in question as intended by the District Court, and held that

the District Court did not abuse its discretionary power in awarding attorneys' fees in this case.

The record clearly shows this to be an ordinary patent case. There is not an iota of evidence to show that there are any special circumstances which would warrant the assessment of attorneys' fees. The record is entirely devoid of any showing that petitioner is guilty of fraud, malice, dilatory practices or vexatious acts in this case; they are entirely absent. Clearly, extended litigation involving petitioner's patents does not constitute special circumstances warranting the assessment of attorneys' fees in this case.

Since entry of the judgment, at least three United States District Courts in patent cases on the order of the present case have refused to assess attorneys' fees against the losing party. See *Lincoln Electric Co.* v. *Linde Air Products Co.*, 74 F. Supp. 293, *National Brass Company* v. *Michigan Hardware Company*, 75 F. Supp. 140; *Juniper Mills, Inc.*, v. *J. W. Landenberger & Co.*, 76 U.S.P.Q. 300.

The decision of the District Court in this case with respect to attorneys' fees, which the Circuit Court of Appeals for the Seventh Circuit refused to review, even though the question was certified to it for decision, is in clear conflict with the decisions of other District Courts in the Second and Third Circuits.

It is unlikely and highly improbable that Circuit Courts of Appeals will review and interpret the general provisions of Revised Statutes, 35 U.S.C.A., Sec. 70 (with the possibility of ultimate conflict of decisions) with respect to when the assessment of attorneys' fees is proper because of the discretionary powers reposing in the District Courts. Thus, there is an important question of federal law which has not been settled, but should be settled

now by this Court in the interest of uniformity in the decisions of the Courts of the Federal Judicial Circuits.

For the reasons above stated, it is urged that the petition for writ of certiorari be granted.

Respectfully submitted,

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